

REMARKS

Applicants' invention is directed to a sound dampening pad comprising a length of flexible polymeric material having a generally curved configuration when viewed from an end thereof. The pad has inner and outer surfaces, with the inner surface comprising the inner radius of the curved configuration and the outer surface comprising the outer radius of the curved configuration. At least a portion of the inner surface of the curved configuration includes a pressure sensitive adhesive thereon. Different embodiments of the curved configuration are described including a J-shaped configuration and a U-shaped configuration. The sound dampening pad is easy to manufacture and install onto printing blanket sleeves and effectively attenuates noise emanating from the sleeves during air pressurized mounting and dismounting thereof.

In the first Office Action, the Examiner objected to the drawings for failing to illustrate a the claimed embodiment (original claim 9) of a U-shaped sound dampening pad. Applicants submit herewith a new Fig. 6 directed to that embodiment of the invention. No new matter has been added. The drawing is identical to original Fig. 2, except that the U-shaped embodiment of the pad is depicted. Such a U-shaped embodiment was described in words in the originally filed specification, for example, at page 6, paragraph [0025] and original claim 9. Applicants submit that the drawings are now in compliance with 37 CFR 1.83(a).

Also in the first Office Action, the Examiner objected to the specification as failing to recite the current status of the parent application. Applicants have amended the specification to provide the updated status information.

Also in the first Office Action, the Examiner rejected claims 1-9 under 35 USC §103 as unpatentable over Ang et al ("Ang") in view of Caldwell et al ("Caldwell"). The Examiner, referring to Fig. 4, element 50, asserted that Ang teaches a sound dampening pad comprising a length of flexible polymeric material "having a generally J-shaped configuration" and having an adhesive on at least a portion of the inner surface of such J-shaped configuration. Ang was conceded not to teach a pressure sensitive adhesive. However, Caldwell was cited as showing a sound dampening pad that included a pressure sensitive adhesive. The Examiner concluded that

it would have been obvious to employ a pressure sensitive adhesive as taught by Caldwell in the pad of Ang.

Applicants challenge both the Examiner's factual assertions concerning the prior art as well as the lack of suggestion or motivation to combine the teachings of the cited references. It is well settled that it is the Examiner's initial burden to establish the evidentiary basis for obviousness. The Examiner asserted that elastomer body 48 in Fig. 4 of Ang (the Examiner referred to "Item 50" which is really just one leg of the body 48) is "J-shaped." Applicants strongly disagree. Fig. 4 clearly depicts an L-shaped polymer having a longer leg 50 and a shorter leg 52 at a right angle to leg 50. This is confirmed by Ang at col. 5, lines 31-32, which states: "Thermoplastic elastomer body 48 has an L-shaped transverse cross section having inner sides 50 and 52."

Applicants teach several advantages of curved J- or U-shaped pad configurations for the sound dampening pad at page 5, paragraph [0017], page 7, paragraph [0028], and page 9, paragraphs [0035] and [0036]. None of these advantages are available for the L-shaped body of Ang. Nor does Caldwell make up for this deficiency in Ang. Thus, applicants submit that neither Ang, nor Caldwell, nor any combination thereof teaches or suggests applicant's claimed sound dampening pad construction.

Further, the Examiner asserted that it would have been obvious to use the pressure sensitive adhesive of Caldwell in Ang's construction. However, there must be some suggestion or motivation *in the prior art* and not applicants' disclosure to make the proposed combination. Here, neither Ang nor Caldwell are concerned with noise and vibration problems resulting from the use of pressurized air to mount and dismount blanket sleeves in an offset printing operation. Further, Ang desires an *automated* process using a robotic arm for use in the manufacture of automobiles in which molten elastomer is extruded onto another plastic surface and becomes "self-adhered" thereto when cooled. See, generally, col. 3 at lines 5-18, and lines 28-64. Ang *criticizes* prior art sound dampening components in the automotive industry that used adhesives. See, col. 1 at lines 25-42 (prior art is labor intensive and results in poor quality due to human error and poor adhesion).

Given that Ang explicitly teaches a self-adhered pad which eliminates the need for adhesive, there is no motivation for one skilled in the art to modify Ang to do what Ang

expressly says **not** to do. Further, the reasoning given by the Examiner for making the proposed combination was that providing Ang's body with Caldwell's adhesive "would provide the sound dampening pad with a ready-to-lay convenience that is easily applicable and well adapted for manual application, eliminating a time consuming application of an adhesive at the time of attachment to an element to be damped" (Office Action, Page 4). However, Ang expressly states that the inventors desire an automated, not manual, process, and one which does not need the separate application of pressure sensitive adhesives. Thus, the evidence of record is that one skilled in the art would not modify Ang in the manner proposed because Ang automates a previously manual procedure and Ang eliminates any need to apply a separate pressure sensitive adhesive to the product. For all of the above reasons, the rejection is not well-taken and should be withdrawn.

With respect to dependent claims 6 and 7, the Examiner asserted that Ang teaches mounting of a pressure sensitive adhesive on the longer leg of a J-shaped configuration and configuring the shorter leg of a J-shaped configuration so that it does not extend to the adhesive, referring to col. 4, line 48 through col. 5, line 11. Applicants can find no such teachings in Ang. As noted above, Ang fails to teach or suggest a sound dampening pad having a J-shaped configuration. In the passage relied upon by the Examiner, Ang discusses possible alternative *mechanical* attachment designs for the body. Nowhere does Ang mention applying a pressure sensitive adhesive to any portion of the body. For these additional reasons, claims 6 and 7 are patentable over the cited references.

Serial No. : 10/757,229
Atty. Dkt. No. DAY0807VA/40195.817

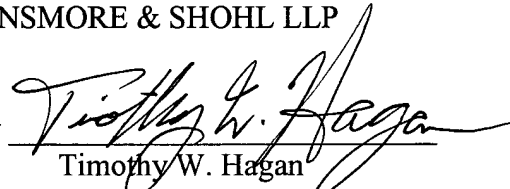
- 10 -

For all of the above reasons, applicants submit that claim 1-9 are patentable over the references of record. Further, the specification and drawings have been amended to comply with the Examiner's requirements. Early notification of allowable subject matter is respectfully solicited.

Respectfully submitted,

DINSMORE & SHOHL LLP

By


Timothy W. Hagan
Registration No. 29,001

One Dayton Centre
One South Main Street, Suite 1300
Dayton, Ohio 45402-2023
(937) 449-6400
Facsimile: (937) 449-6405
E-mail: tim.hagan@dinslaw.com
TWH/

AMENDMENTS TO THE DRAWINGS

In the Office Action, the Examiner objected to the drawings for failing to show the U-shaped configuration for the sound dampening pad presently claimed in claim 9. Applicants submit herewith a new Fig. 6 directed to that embodiment of the invention. No new matter has been added. The drawing is identical to original Fig. 2, except that the U-shaped embodiment of the pad is depicted. Such a U-shaped embodiment was described in words in the originally filed specification, for example, at page 6, paragraph [0025] and original claim 9.